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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,284	06/12/2000	FRANCOIS SMOLAREK	106498	5209

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EXAMINER

HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 06/03/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

AS18

Office Action Summary

Application No.

09/592,284

Applicant(s)

SMOLAREK, FRANCOIS

Examiner

Donald Heckenberg

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-128 is/are pending in the application.
- 4a) Of the above claim(s) 87-98, 116, 117 and 127 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-79, 82-86, 99, 100, 102-115, 118-126, and 128 is/are rejected.
- 7) ☒ Claim(s) 80, 81 and 101 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1722

1. Amended claims 87-97 and newly added claims 98, 116-117, and 127 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 87-98, 116-117, and 127 are directed to a method for manufacturing a stick of cosmetic product, whereas the originally presented claims are directed to a mold for manufacturing a stick. These two inventions are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. MPEP § 806.05(e). In this case, the apparatus as claimed can be used to practice another and materially different process such as a process wherein the molding material is injected into the mold rather than by "pouring" the material into the mold as required by the method claims.

Since Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 87-98, 116-117, and 127 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP §§ 818.02(a), 821.03.

Art Unit: 1722

2. The following is a quotation of the first paragraph of 35

U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-10, 55-65, 68-69, 74, 118-120, and 125 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

The originally filed application did not set forth that the inner surface of the mold is "seamless". Therefore this limitation constitutes new matter. Note, the mere absence of a positive recitation is not the basis for a negative limitation such as "seamless." See MPEP § 2173.05(i).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

Art Unit: 1722

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6, 9, 33-38, 42-49, 53-54, 69, 72-73, 75-79, 84-86, 99-100, 102-104, 106, 110-115, 118, 120, 123-124, 126, and 128 are rejected under 35 U.S.C. 102(b) as being anticipated by Henning (U.S. Pat. No. 3,934,810).

Henning teaches a mold wherein the mold has a seamless inner surface (defining cavity 81) and a side wall which includes zones of weakness facilitating radial deformation thereof (see column 1, lines 59-66). Henning further teaches the zones of weakness to be notches (87) made in the side wall of the mold, uniformly distributed in a periphery of the mold (see figure 8). Henning also teaches the notches to extend over substantially an entire height of the mold all the way to the bottom of the mold beyond the bottom of the cavity (figure 7), and the bottom of the notches to be rounded (93). As shown in scale of figure 8, Henning further teaches that the thickness of the side wall between the notches and the cavity is greater than 1 mm, and that the notches have a depth greater than 4 mm.

Henning further teaches in the embodiment shown in figures 2, 5-6, the notch to be formed in the side of the mold such that the depth of the notch decreases towards the bottom of the mold. Henning also discloses the mold to have a top portion with a

Art Unit: 1722

flange surrounding the opening in the mold (see figure 2), and part of the recess having a width such that there is at least one gap (33) in an outer boundary of the side wall of the mold when the mold is at rest (see figure 1).

Claims 69, 72-73, 86, and 114 recite that the mold is configured to be filled with a cosmetic product. The actual intended use of the apparatus, whether it be to make a cosmetic product or anything else, is not germane to the issue of patentability of the apparatus claims. If the prior art structure is capable of performing the claimed use, then it meets the claim limitation(s). In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (Cust. & Pat. App. 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (Cust. & Pat. App. 1963); see also MPEP § 2115. In the instant case, Henning teaches the mold to be used with "a hardenable mixture" (col. 1, ln. 6), and to comprise a completely closed cavity (81) for containing the mixture (see fig. 7). Therefore, the apparatus of Henning is capable of being used with a hardenable mixture such as that which would form a cosmetic product, and therefore anticipates the limitations of claims 69, 72-73, 86, and 114.

Claim 118 recites that the mold is made of a material that is physically and chemically compatible with polydimethyl siloxane silicon at a temperature of about 100°C. Although

Art Unit: 1722

Henning does not disclose the use of the apparatus for molding polydimethyl siloxane silicon, this actual use of this material is a limitation is directed towards the intended use of the apparatus, which is not germane to the issue of patentability as discussed above. Henning does disclose that the apparatus is capable of molding hardenable materials. (see for example, column 1, lines 3-6). Given this structure, the mold of Henning would inherently have to be made of a material physically and chemically compatible with polydimethyl siloxane silicon.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

Art Unit: 1722

3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 7-8, 10, 39-41, 50-52, 82-83, 105, and 107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henning.

Henning teaches the mold as described above. Henning does not disclose the mold to have sixteen to twenty notches, or more specifically, eighteen notches. However, Henning does teach that the number of notches is not critical, and that more or less can be added (see column 4, lines 30-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the mold of Henning as such to have provided eighteen notches because number of notches is not critical and could be adapted to meet a particular use of the apparatus as suggested by Henning.

9. Claims 11-32, 55-68, 70-71, 74, 108-109, 121-122, and 125 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henning as applied to claims 1-10, 22-54, 69, 72-73, 75-79, 82-83, 84-86, 99-100, 102-107, 110-115, 118, 120, 123-124, 126, and 128 above, and further in view of Fox et al. (U.S. Pat. No. 3,937,438; previously of record).

Henning teaches the apparatus as described above. Henning fails to teach the mold cavity-opening to have a sloping bottom wall, or a cavity having a part formed by two successive conical surfaces converging towards an opening in the mold, or the cavity to be partially defined by a conical surface.

The mold cavity-opening shape determines the shape of the product to be manufactured. Henning teaches different cavity shapes which would form products of different shapes (compare cavity 25 in the embodiment shown in figures 2-4, with cavity 81 shown in figures 7-8). In the same field of endeavor, Fox teaches another example of a different cavity shape (21) to produce different shaped products (45). Therefore, it is known in the art that the shape of the cavity may be manipulated in order to produce products of different shapes.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the mold cavity of Henning as such to have a slopping bottom wall, two successive converging conical surfaces, or be partially defined by a conical surface because these cavity shapes would have allowed for the molding of correspondingly shaped products as is suggested by Henning and Fox.

10. Applicants arguments filed March 20, 2003 have been considered but are not persuasive.

Applicant asserts that claim 87, as amended, is closely related to the originally presented claims directed to a mold. Therefore, Applicant concludes that the method claims be examined with the apparatus claims.

As set forth above, the method claims are of a different scope than the apparatus claims. As such, the method claims would require further search in areas wherein the apparatus claims would not. Therefore, there would be a burden on the Office to examine the additional method claims, and restriction is proper.

With respect to the rejection of claims 1-10, 55-65, 68-69, 74, 118-120, and 125 under 35 U.S.C. 112, first paragraph, Applicant argues that originally filed figure 2 of the instant application clearly illustrates that the inner surface of the mold is seamless.

Figure 2 does not reference, by numeral or otherwise, the inner surface of the mold. Further, figure 2 of the instant application only shows a quarter section of the mold. As such, the figure does not show the inner surface to be seamless, as it does not even show the entire inner surface. The claims reciting the inner surface to be seamless include new matter as there

Art Unit: 1722

being no other reference to a seamless inner surface in the originally filed disclosure.

With respect to the rejection of claims 1, 33, 44, and 75, Applicant argues that the Henning reference is not analogous to the subject matter of the instant application. Applicant cites In re Clay, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992) as setting forth the criteria for determining whether the prior art is analogous. Applicant notes that Henning discloses flexible distensible molds for shaping art forms and other materials, and thus Applicant argues that Henning is not in the same field of endeavor as the claims of the instant application. Applicant further argues that Henning is not reasonably pertinent to the problem with which Applicant's invention is involved.

As set forth in the previous Office Action and repeated above, claims 1, 33, 44, 75, and many claims that depend from these claims, are anticipated under 35 U.S.C. 102. Applicant's arguments with respect to these claims are not proper for a rejection under by Henning 35 U.S.C. 102. The test for analogous art cited by Applicant is only applicable to rejections under 35 U.S.C. 103. If a prior art structure anticipates all limitations of a claimed invention, the field of endeavor is irrelevant. Claims 1, 33, 44, 75, and the claims that depend from these claims are not limited to applications of making cosmetic

Art Unit: 1722

products. The only reference in these claims to cosmetic products occurs in the preamble to these claims, specifically stating the mold is "for manufacturing a stick of a cosmetic product." A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (Cust. & Pat. App. 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (Cust. & Pat. App. 1951); see also MPEP § 2111.02. As there is nothing further in the claims referring to the preamble, the recited "for manufacturing a stick of a cosmetic product" does not limit the apparatus claimed. As such, Henning anticipates all of the claim limitations of claims 1, 33, 44, 75, and claims that depend from as set forth above.

With respect to the rejection under 35 U.S.C. 103, Applicant notes that neither Henning or Fox disclose the use of the mold for manufacturing a stick of a cosmetic product. Applicant argues therefore, that the combination of Henning and Fox are not analogous subject matter.

As discussed above, the only recitation of the use of the mold for making cosmetic products occurs in the preamble of the

Art Unit: 1722

claims, and as such the claims of the instant application are not limited to such a use. Applicant acknowledges that Henning and Fox are themselves in the same field of endeavor, and have the same objective (Response, p. 10, lines 20-23). As set forth above, there is motivation to modify the Henning. Accordingly, Henning and Fox do render obvious the structure of the claimed invention.

Assuming arguendo that the claims of the instant application defined an invention that was not in the same field of endeavor as Henning and Fox, it still appears that the second prong of the test set forth in In re Clay would be met. That is, the references are reasonably pertinent to the particular problem with which the invention is involved. One of the main objectives Henning and Fox is to make a flexible mold for which withdrawal bore of the shaping cavity can be enlarged, which is a problem with which the instant invention is concerned (see for example, specification p. 2, lines 6-14).

Applicant's arguments with respect to newly submitted claims 98-100, 102-118, and 120-128 have been considered but are moot in view of the new grounds of rejection.

11. Claims 80-81, and 101 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten

Art Unit: 1722

in independent form including all of the limitations of the base claim and any intervening claims.

12. Claim 119 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

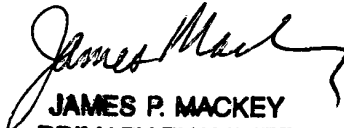
Art Unit: 1722

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (703) 308-0457. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for responses to non-final action, and 703-872-9311 for responses to final actions. The unofficial fax phone number is (703) 305-3602.


Donald Heckenberg
May 29, 2003


JAMES P. MACKEY
PRIMARY EXAMINER
5/30/03